

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed November 21, 2006. At the time of the Final Office Action, Claims 1-3, 5-10 and 14-17 were pending in this Application. Claims 4 and 11-13 were previously withdrawn due to an election/restriction requirement. Claims 1-3, 5-10, and 14-17 stand rejected. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 6-10 stand rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by JP 62240237 A filed by Kawamoto Takahiro et al. (“Takahiro”). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the cited art as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

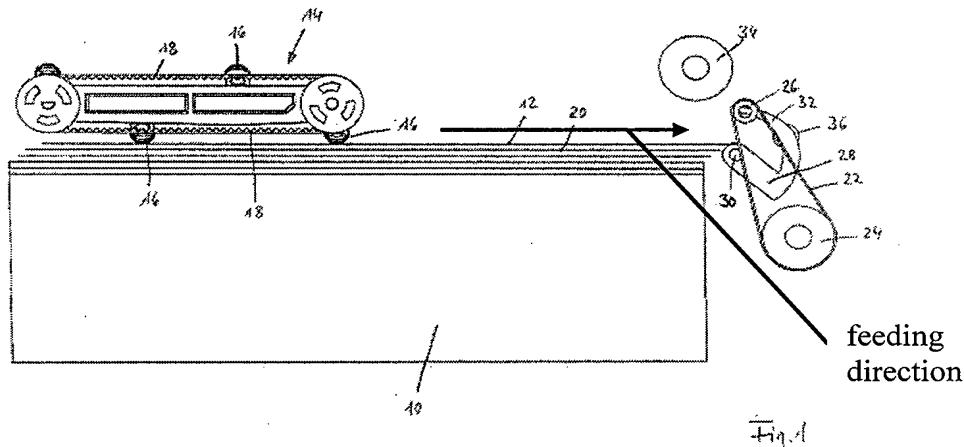
Claim 6 recites “the stop can be moved upwards at an impingement angle of *more than 90 degrees in relation to a flat plane and a direction in which the uppermost sheet is fed.*” (emphasis added). According to the specification,

In order to put this effect to use, the impingement angle of the stop in relation to the flat plane of the fed sheet should be at least 90 degrees. An impingement angle of more than 90 degrees, most advantageously about 100 degrees, or setting the stop in a *slightly tilted position in relation to the pile*, has the advantage that the front edge of the sheet will be maintained contiguous with the stop also when the front edge of the sheet moves upwards in a bow-shaped form.

(Specification, 6:26-7:3) (emphasis added). The specification clearly teaches and claim 6 recites that the stop is positioned at an angle relative to a flat plane parallel to the pile of paper. With reference to Figure 1, the specification teaches,

On the pile 10 there is a rolling action device 14, which corresponds to the rolling action device described, for instance, in DE 100 16 793 A1. This rolling action device 14 has rolling elements that are built as freely revolvable bearing housed turning rollers 16. These turning rollers 16 are embedded onto an endlessly running tractive device 18. The turning rollers 16 are moved in *the feeding direction by the driven tractive device 18, or in the figure, to the right over the uppermost sheet 12 of the pile 10.*

(Specification at 8:21-9:2) (emphasis added).

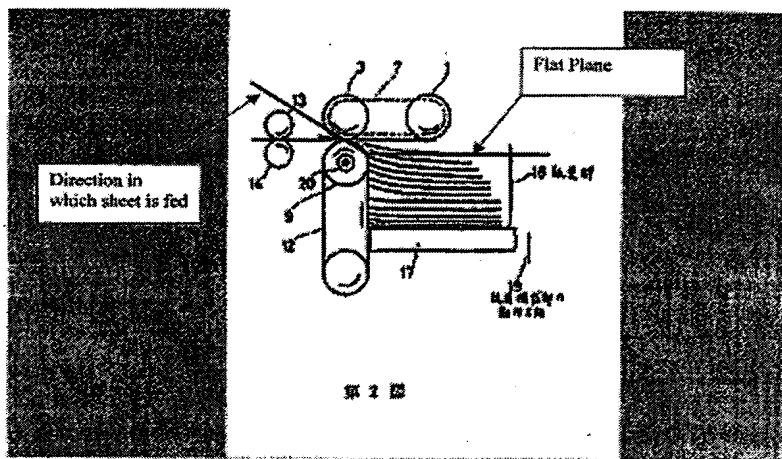


(Specification at Figure 1) (notations added).

The continuously running turning rollers 16 push this curvature in front of themselves, whereby *a feeding force is being exercised in direction to the right on the uppermost sheet 12 and in a decreasing degree on each of the following sheets in the pile 10.* In this way, the upper sheets of the pile 10 are fanned out in the form of scales as this can be seen in Figure 1.

(Specification at 8:21-9:2) (emphasis added). The feed direction is horizontally to the right in Figure 1.

A premise of the rejection is that Takahiro illustrates that the direction in which the sheet is fed has a vertical component so that the feed direction is inclined approximately 40 degrees from horizontal.



(OA at 3). It should be noted, however, that in the context of the claims and specification of the present invention, the “paper sheet placing unit 17” of Takahiro is the device upon which the pile of paper sits in a horizontal position. The sheets of paper are in the horizontal position when they are engaged by the “drawing belt 12.” Further, when the individual sheets are fed from the pile of paper into the “feed roller 14,” the sheets are horizontal as clearly shown in Figure 2. Thus, the sheets are perfectly horizontal before and after they are engaged by the drawing belt 12. Notwithstanding, in the drawing provided in the Office Action, the feed direction is improperly identified as the direction of the lifted portion of the top sheet of paper as the edge of the sheet is being lifted by the alleged “stop” (drawing belt 12). The fact that the edge of the paper is lifted during the separation process does not change the defined orientation of the “feed direction.” For example, Figure 2 of the present specification also illustrates that the top sheet of paper is inclined as it is engaged by the stop.

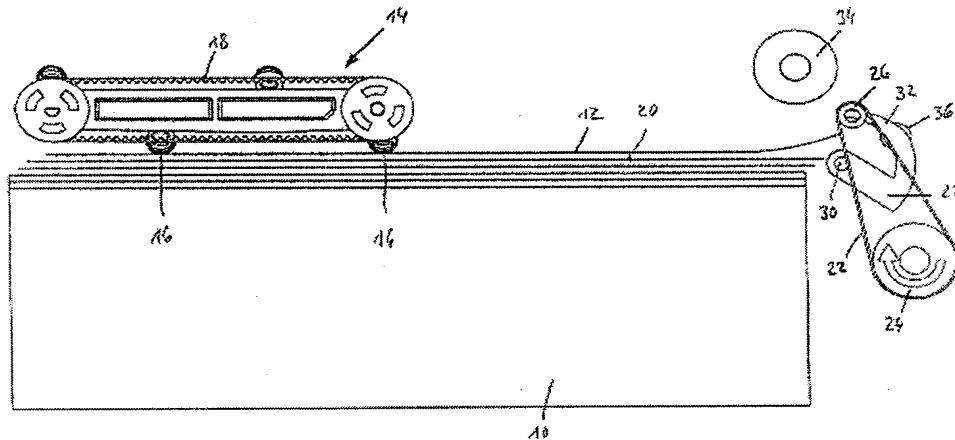


Fig. 2

But this fact does not change the defined "feed direction" as being horizontally to the right. Thus, the premise of the rejection, which places the "feed direction" in Figure 2 of Takahiro at an incline, is incorrect in the context of the invention as claimed in claim 6 of the present application.

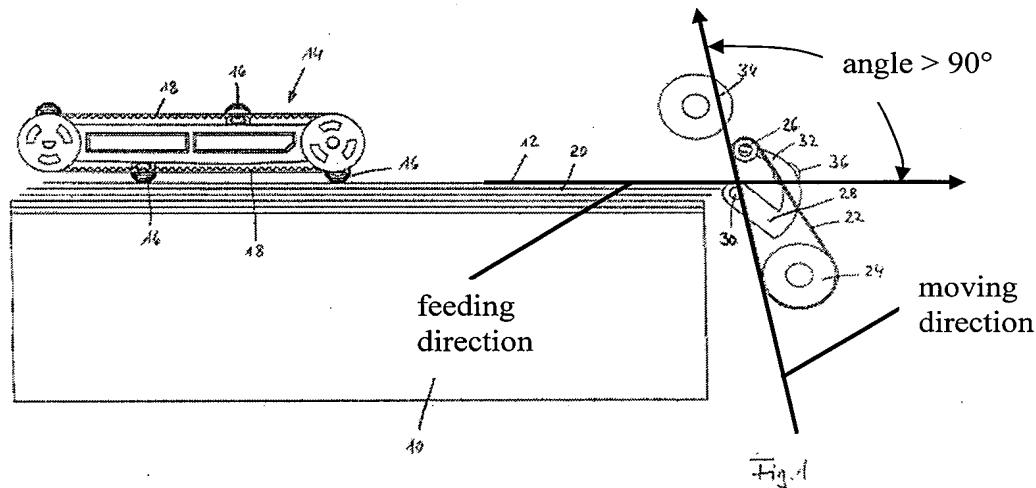
Takahiro fails to teach or suggest the invention as claimed in claim 6 because it shows that the drawing belt 12 is positioned to be 90 degrees relative to the horizontal paper stack.

A fine dislocation is caused among the respective paper sheets in the group of the paper sheets 18 and a larger dislocation is caused at the upper portion by the same force as compared with the lower portion due to the effect of the weight of the respective paper sheets as far as the entire group of the paper sheet 18 is concerned.

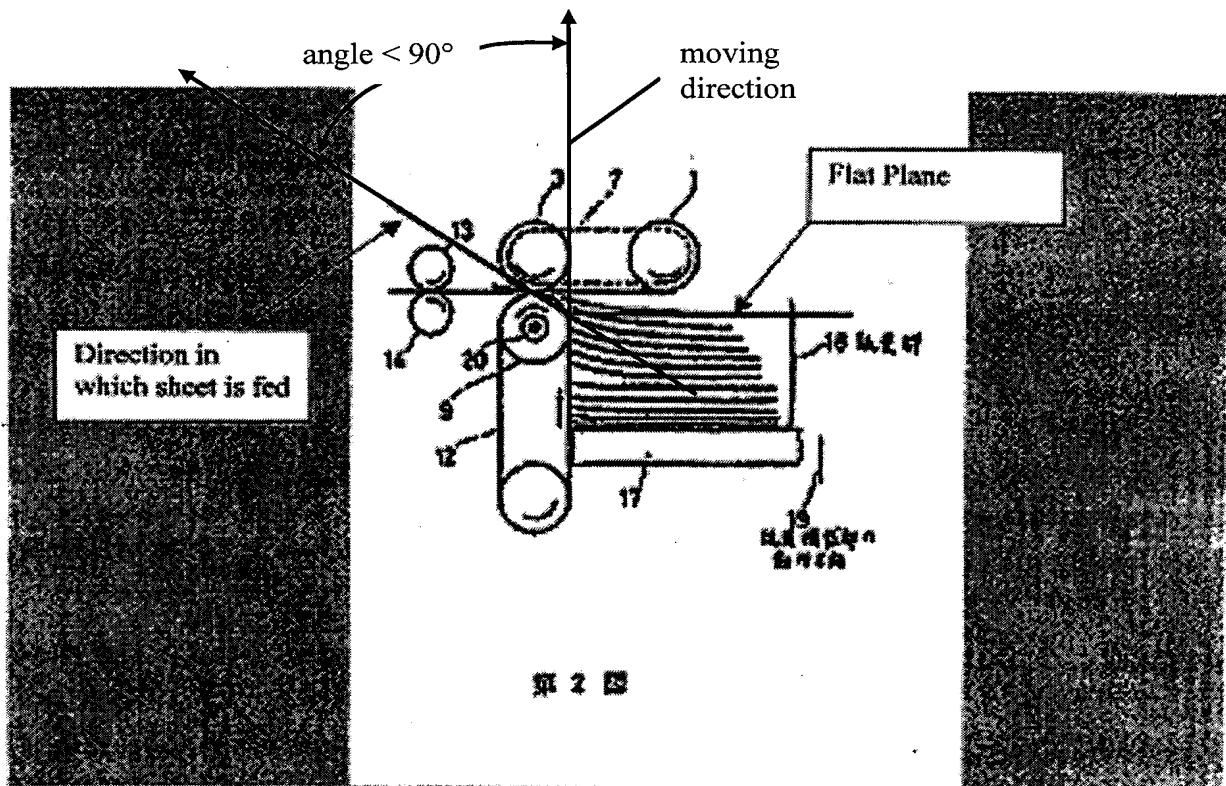
(Takahiro, abstract). Takahiro teaches an impingement angle of 90 degrees so as to apply the same contact force with all of the papers in the paper stack. With the same contact force being applied to the entire stack, only the top paper sheets become dislocated because they are not weighted down by additional paper sheets. According to Takahiro the stack of paper sheets is moved with its front side completely against the drawing belt 12 by the placing unit 17. Only in this way all the paper sheets can be lifted at their front edges by the belt 12 (in a different amount due to the effect of the weight of the papers of the upper part of the stack). Roller 1 does not contact the uppermost sheet of the stack (as can be seen from Figs. 1 and 2 of Takahiro) but drives roller 3. Thus, Takahiro teaches away from an impingement angle of

more than 90 degrees. The invention as claimed in claim 6 is patentable in view of Takahiro. The invention of claims 7-10 is patentable for similar reasons.

Further, if the feed direction identified in the Office Action were accepted as correct, a premise with which the applicants do not agree, then the angle between the feed direction and the moving direction of the stop belt would be less than 90° , not greater than 90° as required by the claims. As noted above, claim 6 recites “the stop can be moved upwards at an impingement angle of *more than 90 degrees in relation to a flat plane and a direction in which the uppermost sheet is fed.*” (emphasis added). The relative directions are illustrated with respect to Figure 1.



(Specification at Figure 1) (notations added). Alternatively, if the feeding direction adopted as a premise of the rejection is adopted, the impingement angle is less than 90° as illustrated below.



Therefore, if the feed direction adopted as a premise of rejection were taken as correct, the result is that the impingement angle is less than 90°. Under that interpretation of the claims, the prior art fails to teach all of the claim elements. For this additional reason, the invention as claimed in claim 6 is patentable in view of Takahiro. The invention of claims 7-10 is patentable for similar reasons.

Rejections under 35 U.S.C. §103

Claims 1-3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Takahiro. Applicants respectfully traverse and submit the cited art does not render the claimed embodiment of the invention obvious. Claim 1 recites, "subjecting the uppermost sheet of the pile to a rolling action, through which the uppermost sheet is loosened from the next sheet on the pile and is *moved in the feeding direction*, moving the uppermost sheet with

its front edge against a stop, which is moved under an impingement angle of more than 90 degrees in relation to a flat plane and a *direction, in which the uppermost sheet is being fed.*” As noted above, the specification clearly teaches that the feeding direction is horizontally to the right in Figure 1. This holds true even though the leading edge of the sheet is lifted after engagement with the stop as illustrated in figure 2 of the specification. A premise of the rejection is that the feeding direction is that of the leading edge of the paper after it is lifted by the stop. However, as noted above, that premise is incorrect in view of the clear claim language and the express teaching of the specification. Further, if the feeding direction identified in the office action were taken as correct, a premise with which the applicants do not agree, then Takahiro fails to teach an impingement angle of greater than 90°. Takahiro fails to teach or suggest the invention as claimed in claim 1. The invention as claimed in claims 2-3 is patentable for similar reasons.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Takahiro in view of U.S. Patent 4,579,329 issued to Walter W. Frost et al. (“Frost”). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious. For the reasons noted herein, the invention as claimed in claim 5 is patentable in view of Takahiro and Frost.

Claims 14-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Takahiro in view of Frost. Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious. For the reasons noted herein, the invention as claimed in claim 14-16 is patentable in view of Takahiro and Frost. Claim 17 recites “a rolling action device that lies on the uppermost sheet of the pile and exerts a rolling action on the uppermost sheet in a feeding direction.” Similar to the discussion above relative to the invention as claimed in claims 1 and 6, this “feed direction” is the horizontal direction to the right as shown in Figure 1 of the specification. Thus, the invention as claimed in claim 17 is patentable in view of Takahiro and Frost.

Association of Customer Number and Change of Correspondence Address

Applicants respectfully request that all papers pertaining to the above-captioned patent application be associated with Customer No. **31625**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **31625**. All telephone calls should be directed to William Beard at 512.322.2690.

ATTORNEY DOCKET
074623.0111

PATENT APPLICATION
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CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2690.

Respectfully submitted,
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